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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/564,643

01/13/2006

Kazutoyo Watanable

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EXAMINER

GREENE, JASON M

ART UNIT

PAPER NUMBER

1797

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/564,643	<b>Applicant(s)</b> WATANABLE ET AL.	
	<b>Examiner</b> Jason M. Greene	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/13/06</u> .   | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 13 January 2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Otsubo et al. (US 7,090,714 B2).

The applied reference has a common assignee and one common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Otsubo et al. discloses a ceramic honeycomb filter comprising pluralities of ceramic honeycomb structures (11,12) each having large numbers of flow paths partitioned by cell walls, which are bonded in the direction of said flow paths, predetermined flow paths being sealed by plugs, plugs formed at one end of at least one honeycomb structure being bonded to at least part of plugs formed at one of a honeycomb structure adjacent to said end of this honeycomb structure, wherein a first ceramic honeycomb structure with predetermined flow paths sealed by plugs at one end is bonded to a second ceramic honeycomb structure with predetermined flow paths (near the outer periphery) sealed by plugs at both ends, such that the first ceramic honeycomb structure is on an upstream side, wherein a ratio  $A/B$  of the length  $A$  of the plugs at one end of the honeycomb structure to the length  $B$  of the plugs at one end of the other honeycomb structure is 1/1 in the bonded plugs, wherein pluralities of ceramic honeycomb structures are provided with an integral outer wall, and wherein a catalyst is supported by the cell walls (see col. 10, lines 14-20) in Figs. 7(d)-7(f) and col. 5, line 33 to col. 12, line 47.

4. Claims 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Otsubo et al. (US 7,090,714 B2).

Otsubo et al. discloses a method for producing a ceramic honeycomb filter with predetermined flow paths sealed by plugs, wherein in the bonding of pluralities of ceramic honeycomb structures each having large numbers of flow paths partitioned by cell walls in the direction of the flow paths, plugs formed at one end of at least one honeycomb structure are bonded to at least part of plugs formed at one end of a honeycomb structure adjacent to this honeycomb structure, and comprising cutting one monolithic ceramic honeycomb structure substantially perpendicular to the flow paths to form pluralities of ceramic honeycomb structures, abutting the ends of the cut ceramic honeycomb structure, such that at least part of plugs in the ceramic honeycomb structures at ends are abutted to each other, wherein at least part of plugs formed at one end of the honeycomb structure have protruding portions in Figs. 7(d)-7(f) and col. 5, line 33 to col. 12, line 47.

5. Claims 1-5 are rejected under 35 U.S.C. 102(a) as being anticipated by Otsubo et al. (US 2004/0065068 A1).

The Examiner notes that the reference qualifies as prior art since it names a different inventive entity than the instant application. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Otsubo et al. discloses a ceramic honeycomb filter comprising pluralities of ceramic honeycomb structures (11,12) each having large numbers of flow paths partitioned by cell walls, which are bonded in the direction of said flow paths, predetermined flow paths being sealed by plugs, plugs formed at one end of at least one honeycomb structure being bonded to at least part of plugs formed at one of a honeycomb structure adjacent to said end of this honeycomb structure, wherein a first ceramic honeycomb structure with predetermined flow paths sealed by plugs at one end is bonded to a second ceramic honeycomb structure with predetermined flow paths (near the outer periphery) sealed by plugs at both ends, such that the first ceramic honeycomb structure is on an upstream side, wherein a ratio A/B of the length A of the plugs at one end of the honeycomb structure to the length B of the plugs at one end of the other honeycomb structure is 1/1 in the bonded plugs, wherein pluralities of ceramic honeycomb structures are provided with an integral outer wall, and wherein a catalyst is supported by the cell walls (see col. 10, lines 14-20) in Figs. 7(d)-7(f) and paragraphs [0039] to [0071].

6. Claims 6-8 are rejected under 35 U.S.C. 102(a) as being anticipated by Otsubo et al. (US 2004/0065068 A1).

The Examiner notes that the reference qualifies as prior art since it names a different inventive entity than the instant application. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

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### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

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double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, 2 and 4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 7,090,714

B2. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The claims of the '714 patent recite a bonding layer being formed near an outer peripheral wall of the filter. As is especially evident from Figs. 7(d)-7(f), the bonding layer closes several flow paths and therefore reads on the term plugs in the instant claims. While the claims in the '714 patent are directed to the bonded plugs being located near a periphery of the honeycomb structures, they nevertheless anticipate the instant claims. Anticipation is the epitome of obviousness.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Ishihara et al., Ohashi et al., Best et al., Waschuttis and Hervert references disclose similar honeycomb structures.



10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Greene whose telephone number is (571) 272-1157. The examiner can normally be reached on Monday - Friday (9:00 AM to 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason M. Greene  
Primary Examiner  
Art Unit 1797

/Jason M. Greene/  
8/2/08

jmg  
August 2, 2008